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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/057,184	01/23/2002	Olivier H. Sudre	26409.00100	5284
28983	7590	03/16/2004	EXAMINER	
REED SMITH CROSBY HEAFETY LLP 1901 AVENUE OF THE STARS, SUITE 700 LOS ANGELES, CA 90067				MCNEIL, JENNIFER C
ART UNIT		PAPER NUMBER		
		1775		

DATE MAILED: 03/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/057,184	SUDRE ET AL.
	Examiner	Art Unit
	Jennifer C McNeil	1775

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 08 December 2003.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-43 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-13,18-29 and 34-41 is/are rejected.
- 7) Claim(s) 14-17,30-33,42,43 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_.

## DETAILED ACTION

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3, 7, 8, 11, 12, 18-20, 24, 25, 28, 34, 37, and 40 are rejected under 35 U.S.C. 102(b) as being anticipated by Morgan et al. Please refer to the previous office action for the text of the rejection.

Claims 1, 7, 8, 11-13, 18, 24, 25, 28, 29, 34, 40, and 41 are rejected under 35 U.S.C. 102(e) as being anticipated by Merrill. Please refer to the previous office action for the text of the rejection.

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-12, 18-28, 34, 35, and 36-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hunt et al. Hunt teaches a phosphate coating with a thickness that may vary. Absent a showing of

unexpected results, it would have been obvious to one of ordinary skill in the art at the time of the invention to deposit the layer of Hunt at a thickness sufficient corrosion resistance.

*Response to Arguments*

Applicant's amendments have overcome the 112 2<sup>nd</sup> paragraph rejection of record.

Regarding applicants argument over Morgan, the LaPO<sub>4</sub> may be present as a layer up to 20 microns (col. 7, lines 15-35). The lanthanum phosphate layer is stable in reactive environments at temperatures up to 2000 degrees Celsius. It is therefore considered to provide thermal barrier characteristics to the rest of the article.

Regarding the rejection over Hunt, applicant argues that the layers are not the unreinforced layers with thermally non-conductive material throughout as contemplated by the present invention. It is not clear where this limitation is found in the claims and is therefore considered not commensurate. Applicant further argues that Hunt does not differentiate between rare earth and other phosphates. This does not define the article over the prior art. Hunt teaches rare earth phosphates and this meets the limitation of the claims. Applicant argues that prior to the present invention it was not known that layers having these properties could be formed from monazites and xenotimes. Is applicant asserting that the layers of the prior art, of commensurate thickness and composition, do not possess the same characteristics as the article claimed? While the references may not explicitly define these characteristics there is no showing that they do not possess these characteristics.

Regarding Merrill, applicant argues that the coatings as described cannot contain monazite or xenotime. Applicant's attention is drawn to the fact that only claims 2 and 19 reflect these two compositions. The remaining claims refer only to rare earth phosphates. Applicant argues that the

phosphate of Merrill provides little or no bonding. It is not clear how this is argument defines over the prior art.

Is the monazite and xenotime characteristic what provides the desired thermal conductivity? If so, then this limitation should be in the independent claims as well.

Applicant's arguments and amendments have overcome the rejections over Glassman, Shoji, Tadokoro, and Boakye.

#### *Allowable Subject Matter*

Claims 14-17, 30-33, 42, and 43 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### *Conclusion*

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer C McNeil whose telephone number is 571-272-1540. The examiner can normally be reached on 9AM-6PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Jones can be reached on 571-272-1535. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



JCM  
March 7, 2004